Remarks

Rejection of Claims under 35 U.S.C. § 112

Claims 22, 29 and 42 have been rejected under 35 U.S.C. § 112 as being indefinite since the terms "the user" and "the command" do not have an antecedent basis. (In the action, claim 1 is indicated as being rejected, but the Applicants believe the Examiner intended claim 22, as claim 1 was previously cancelled, and the rejection of claim 1 under section 112 corresponds to an error found in claim 22.)

Claims 22, 29 and 42 have amended as indicated above. Specifically, the word "web" has been inserted in front of "user" so that it is clear that the "user" is the previously-recited "web user". Also, in claim 29 the term "the command" has been replaced with the previously-recited term "BIT tag". Claim 1 has been further amended to remove the language, "configured to", and to merely use the active verb form, which is more appropriate for a method claim.

The Applicants contend that claims 22, 29 and 42, as amended, are now definite, and therefore request that the rejection of these claims under 35 U.S.C. § 112 be removed.

Rejection of Claims under 35 U.S.C. § 102

Claims 22-25, 29-30, 36-38 and 42 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,466,966 B1 ("Kirsch").

The Applicants respectfully traverse the rejection of claims 22-25, 29-30, 36-38 and 42. The law pertaining to a rejection of a claim under §102 was recited in the earlier RCE. In short, "[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). There must be no difference between the

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claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*

v. Genetech, Inc., id. (emphasis added)).

In the following arguments, the Applicants will focus in particular on independent claims 22, 30 and 42, as the Applicants believe those claims to be allowable over Kirsch. It is axiomatic that any claim which depends from an allowable base claim is also allowable, and therefore the Applicants do not believe it is necessary to present arguments in favor of each and every rejected dependent claim.

The Applicants respectfully contend that the Examiner has mischaracterized Kirsch. The description of Kirsch's method at column 7 is vague and difficult to understand. The Examiner is correct that Col. 7 describes that a web page is returned to the user bearing the user information, but what is not clear from this description is the fact that the web page described at Col. 7 is not the web page to be displayed to the user. Further, the web page to be displayed to the user is only provided as the result of a redirect generated (indirectly) by the first web page. This is made clear in Kirsch at Col. 13, and in Kirsch's Figs. 5, 6 and 7, which provide a much better description of Kirsch's method. It is important to understand Kirsch's method so that the Applicants' claims can be distinguished therefrom. The Applicants would thus like to begin by describing Kirsch's method, as set forth at Col. 13 and Figs. 5-6 of Kirsch.

Attached hereto are enlargements of Kirsch's Fig. 5, annotated according to the accompanying description at Col. 13.

With respect to the attached annotated copy of Fig. 5, a computer system that can perform Kirsch's method is depicted, along with data flow lines representing data transmission steps in Kirsch's method. The data flow lines have been numbered with numbers in circles, representing the sequential flow of data in Kirsch's method, as described at Col. 13. The description at Col. 13, and Fig. 5, should also be

reviewed in conjunction with Kirsch's Fig. 6, which depicts the server-side process for the "content request", and Fig. 7, which depicts the client side for issuing the tracking message.

Specifically, the sequence described at Col. 13, and depicted in Figs. 5-6 of Kirsch, is as follows:

- At step 1, an initial web page request (item 96, Fig. 6; item 108, Fig. 7) from client computer system 80 ("client 80") is sent to the web page server 82. (Kirsch, Col. 13, lines 14-15.)

- At step 2, a corresponding web page 84, containing web page element 86, is returned from the web page server 82 to the client 80. (Id. at lines 15-17).

- At step 3, a notification URL (item 98, Fig. 6; item 112, Fig. 7) is sent from the client 80 to the redirect target server system 88. (The notification URL is described at Col. 13, lines 19-28; the target server system 88 is described at Col. 17, line 27.) More specifically, embedded information in the web page element 86 specifically causes the browser (on client 80) to issue the notification URL. (Col. 13, lines 24-27.)

- At step 4, a redirection message is sent from the target server system 88 back to the client 80. (Col. 13, lines 28-31.) "In connection with the generation of the redirection message, system 88 logs the data received as part of the notification URL 98." (Col. 13, lines 31-34.) (That is, the user data is logged on target server 88 in this step 4.)

- At step 5, based on the redirection message (Col. 13, lines 35-36) an HTTP request (item 102, Fig. 6; item 114, Fig. 7) is sent from the client 80 to "another web page server" 90. (Col. 13, line 56.)

- Finally, at step 6, a web page 92 (item 104, Fig. 6) is returned to the client. The web page 92 is "inferentially referenced by the web page element 86" (Col. 13, lines 40-43).

Kirsch states at Col. 13, lines 57-59 that the order of steps 3 and 5 is not relevant – i.e., the user information can be sent to server 88 before or after the HTTP request for the web page 92 is generated. However, the Applicants contend that this statement is inconsistent with Kirsch's statement that, "Based on the redirection message, the client computer system 80 then preferably issues an HTTP request 102 based on the information contained in the redirection message." (Kirsch, Col. 13, lines 35-36; emphasis added.) This is further supported by Kirsch's claim 1, which states, "processing by said server system [88, Fig. 5] said predetermined redirection and accounting data including providing said client system with a redirection message including reference to said second server system [90, Fig. 5]." (Emphasis added.) Notwithstanding this inconsistency in Kirsch, the Applicants contend that their claims are still allowable over Kirsch, for reasons set forth below.

As stated in Kirsch's own words, "Indeed, as evident to the user of the client computer 80, *the only response recognized as significant is the receipt 116 of the Web page 92.*" (Kirsch, Col. 13, lines 61-64; emphasis added.) That is, the content desired by the user is web page 92, not web page 84. Put another way, web page 84 includes the user information that is to be tracked, but it does not include the page content desired by, and to be displayed to, the user.

With this in mind, the Applicants believe it will now become apparent that the claims are distinguishable over Kirsch.

Claim 22

The Applicants contend that claim 22, and rejected claims 22-25 and 29 which depend therefrom, are not anticipated by Kirsch.

Claim 22 includes the following salient limitations:

A method for tracking the use of a web tool by a web user, comprising, sequentially:

providing a web user through a web user computer access to a web tool;

in response to the user accessing the web tool, <u>inserting within at least one or more web page files</u> a Broken Image Tracking ("BIT") tag that includes <u>user information</u> associated with the web user's use of the web tool and a BIT URL designating a server;

<u>transmitting *from the web tool* to the web user computer the one or more web page files, wherein the one or more web page files are displayed to the user</u>, ...

(Emphasis added.)

As can be seen, Applicants' claim 22 requires that the web tool accessed by the web user provide the web page files that are displayed to the user. This is different from what Kirsch describes. As described in detail above, in Kirsch's method, the web page displayed to the user (web page 92, Fig. 5) is <u>not</u> the web page generated by the "web tool" accessed by the web user ("web page server 82, Fig. 5). Further, in Kirsch the web page (92, Fig. 5) provided to the user does not include any user information.

Additionally, the Applicants still contend that the "Broken Image Tracking" tag and the "BIT URL" of claim 22 are not taught by Kirsch. Kirsch does not recite <u>any</u> component that is consistent with Applicants' description of a BIT tag. The first paragraph under "Detailed Description" in Applicants' specification at page 4 recites, in part:

In general, **a BIT tag is a HTML image tag (or equivalent) with a BIT URL, i.e., a URL that includes embedded user information and a broken image file designator. As used herein, a broken image file is a file that cannot be located, e.g., because it does not exist or because its directory path does not point to it.** The BIT URL has a file path that directs the user's image-retrieving browser to an information gathering ("broken image") web server. With the designated broken image file in the URL, the broken image server will attempt but will not be able to find and retrieve to the browser the broken image file. (Emphasis added.)

Kirsch simply does not contain any disclosure equivalent to the Applicants' claimed "BIT tag", as that term is described by the Applicants' in their specification.

For at least these reasons, the Applicants contend that claim 22, and claims 23-25 and 29 which depend therefrom, are not anticipated by Kirsch.

Moreover, with particular respect to Applicants' claim 26, nothing in Kirsch teaches or suggests storing the user information ("accounting data" of Kirsch) in an error log. Kirsch only describes storing accounting data in a "tracking server" (Col. 5, lines 23-25).

The Applicants therefore request that the rejection of claims 22-25 and 29 as being anticipated by Kirsch be removed and the claims allowed.

Claim 30

The Applicants contend that claim 30, and rejected claims 36-38 which depend therefrom, are not anticipated by Kirsch. With respect to independent claim 30, that claim includes the following salient limitations:

(Continued on next page.)

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A system for tracking web users' use of a web tool, comprising:

a web tool server . . . configured to <u>insert within at least one of the web page files associated with the session</u> a BIT tag including a BIT URL and <u>embedded user information associated with the web user's use of the web tool</u>, and wherein:

the web tool is configured to provide the at least one web page to the web user computer **to be displayed by the web user computer**; ....

(Emphasis added.)

As can be seen, the system of Applicants' claim 30 is configured such that the web page displayed to the user also includes the "user information" to be later stored. As described above, the system of Kirsch is different in that the user information to be stored is <u>not</u> included in the web page to be displayed to the user. As also described above with respect to claim 22, the Applicants still contend that Kirsch does not teach the use of Broken Image Tracking tags or BIT URLs, as <u>no</u> component corresponding to the Applicants' description of a BIT tag" is found in Kirsch. (See Applicants' specification at page 4, first paragraph under "Detailed Description".)

For at least these reasons, the Applicants contend that claim 30, and claims 36-38 which depend therefrom, are not anticipated by Kirsch. The Applicants therefore request that the rejection of claims 22-25 and 29 as being anticipated by Kirsch be removed and the claims allowed.

<u>Claim 42</u>

The Applicants contend that claim 42 is not anticipated by Kirsch. Claim 42 includes the following limitations:

A computer program product ... to perform the following sequential acts:

provide a web user through a web user computer access to a web tool;

in response to the user accessing the web tool, <u>insert within at least one or more web page files</u>, using the web tool, a Broken Image Tracking ("BIT") tag including a BIT URL and <u>embedded user information</u> associated with the web user's use of the web tool; and

<u>transmit from the web tool to the web user computer the one or more web page files</u>; and

<u>wherein, upon receipt of the web page file by the web user computer</u>:

<u>the one or more web page files are configured to be **displayed by the user computer**</u>; .... (Emphasis added.)

Similar to claim 30, discussed above, the computer program product of claim 42 is configured to transmit a web page to a user computer, wherein (1) the web page is configured to be displayed by the user computer, and (2) the web page includes the user information to be stored in a database. This is in contrast to what is described by Kirsch, wherein the "accounting information" to be stored is sent in a <u>first</u> web page, and the web content to be displayed to the user is sent in a <u>second</u> web page. Additionally, the Applicants still contend that the "Broken Image Tracking" tag and the "BIT URL" of claim 42 are not taught by Kirsch. Kirsch does not describe <u>any</u> component that corresponds to the Applicants' "BIT tag", as that term is described by the Applicants' in their specification. (See Applicants' specification at page 4, first paragraph under "Detailed Description".)

For at least these reasons, the Applicants contend that claim 42 is not anticipated by Kirsch. The Applicants therefore request that the rejection of claim 42 as being anticipated by Kirsch be removed and the claim allowed.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 26-27, 31-35, 39 and 41 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,466,966 B1 ("Kirsch") in view of U.S. Published Application US 2003/0220998 A1 to Jennings III et al. ("Jennings").

The Applicants contend that claims 26-27, 31-35, 39 and 41 are not obvious over Kirsch in view of Jennings.

MPEP 706.02(j) states:

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." (Emphasis added.)

With respect to claims 26-27, those claims depend from claim 22. It is axiomatic that any claim which depends from an allowable base claim is also allowable. As set forth above, the Applicants contend that claim 22 is allowable. Accordingly, claims 26-27 are also allowable since they inherently include the

limitations of claim 22. Likewise, claims 31-35 depend from claim 30. As set forth above, the Applicants contend that claim 30 is allowable. Accordingly, claims 31-35 are also allowable since they inherently include the limitations of claim 30. Further, Jennings fails to cure the deficiency in Kirsch, since Jennings does not teach or suggest a web page sent to a user that is displayed to the user, and which also includes user information that is to be sent to a designated server. Further, Jennings does not teach or suggest the use of a BIT tag that, when executed by the user computer, causes the user information to be sent to a designated server.

For at least these reasons, the Applicants contend that claims 26-27 and 31-36 are not obvious over Kirsch in view of Jennings.

With respect to claims 39 and 41, independent claim 39 (and thus, inherently, dependent claim 41) includes the following limitations:

A web tool system having a capability of tracking a user's use of a web tool, comprising:

a web tool server . . . including <u>a web tool program configured to generate and provide to the web user computer one or more web page files</u> in connection with the web user engaging in a session with the web tool, <u>the web tool server further being configured to include in the one or more web page files a BIT tag</u> including a BIT URL <u>and embedded user information</u> associated with the web user's use of the web tool, and wherein:

. . . .

<u>*the at least one web page file is configured to be displayed by the web user computer,* . . . .</u>

(Emphasis added.)

As can be seen, in the web tool system of Applicants' claim 39, the web page that includes the user information is also configured to be displayed on the web user's computer. As variously described above, this is in contrast to what is described by Kirsch. Specifically, in Kirsch the web file that includes the "accounting information" (generally equivalent to Applicants' "user information") is transmitted to the web user's computer separately from the web content page, and the web content page is only transmitted to the user computer as a result of a HTTP request generated by the web page that contains the user information. That is, in Kirsch the web page content intended to be displayed to the user is <u>not</u> part of the web page that includes the user information to be recorded, as is required by Applicants' claim 39. Jennings fails to cure this deficiency, as Jennings does not teach or suggest a web page sent to a user that is displayed to the user, and which also includes user information that is to be sent to a designated server. Further, neither Kirsch nor Jennings teach or suggest the use of a BIT tag that, when executed by the user computer, causes the user information to be sent to a designated server.

Accordingly, since Applicants' claim 39 recites at least one element neither taught nor suggested by Kirsch or Jennings, there can be no § 103 obviousness of Applicants' claim 39. For at least this reason, the Applicants contend that claim 39 is allowable over Kirsch and Jennings. Further, since it is axiomatic that any claim which depends from an allowable base claim is also allowable, claim 41 is also allowable due to its dependency from claim 39.

For at least these reasons, the Applicants contend that claim 39, and claim 41 which depends therefrom, are not obvious over Kirsch in view of Jennings.

For at least all of reasons stated above, the Applicants contend that none of rejected claims 22-27, 29-39, 41, and 42 are anticipated by Kirsch, or are obvious

over Kirsch in view of Jennings. The Applicants therefore respectfully request timely allowance of claims 22-42.
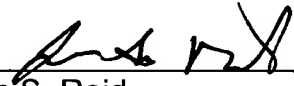
Summary

The Applicants believe that this response constitutes a full and complete response to the Office action, and therefore request timely allowance of all claims 22 through 42.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

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